

APR 11 2003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Grouzmann, *et al.*

Appl. No.: 09/897,433

Filed: July 3, 2001

For: **Treatment of Substance P-Related Disorders**

Art Unit: 1651

Examiner: J. Witz

Atty. Dkt.: 7571/73193
(Formerly 81985/279329)

Response Under 37 C.F.R. § 1.111

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the Office Action dated January 28, 2003, Applicants respectfully request reconsideration of the above-captioned application in view of the following remarks.

I. Status of the Application and Claims

As originally filed, the present application had a total of 18 claims. Claims 2-12 and 14-16 have been withdrawn as the result of a species election. Thus, the claims now pending in the application are 1, 13 and 17-18.

II. The Rejections

On pages 2 and 3 of the Office Action, all pending claims are rejected under 35 U.S.C. § 112, first paragraph, as failing to meet the enablement requirement of patentability. Although the Examiner acknowledges that dipeptidyl peptidase IV (DPP IV) degrades substance P, he argues that there are good reasons for believing that it will not be effective in the treatment of arthritis. In particular, the Examiner cites abstracts by Tanaka, *et al.* (*Int. J. Immunopharmacol.* 19:15-24 (1997); *Immunopharmacol.* 40:21-26 (1998)) and Villhauer (U.S. 6,166,063) as presenting evidence that inhibitors of DPP IV are effective in the treatment of arthritis. The Examiner also cites a patent by Duke-Cohan, *et al.* (U.S. 6,325,989) in which evidence is presented that a form of DPP IV found in